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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/047,081	01/15/2002	Jay Skeen	24228.03	7457

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EXAMINER

LUDLOW, JAN M

ART UNIT	PAPER NUMBER
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1743

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DATE MAILED: 03/19/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/047,081

Applicant(s)

SKEEN

Examiner

Jan M. Ludlow

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-4 and 14-20 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-4 and 14-20 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on ____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). ____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 3. 6) ☐ Other:

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1. Claims 1-17, 19-20 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.
2. There is no teaching in the specification that the tip should (claim 15) or should not (claims 1, 19) have a membrane or filter. There is no teaching in the specification that the legs should be used to avoid mixing of contents as in claims 1 and 19 or what structure would be used or steps would be taken to avoid mixing. There is no teaching of an adapter (claim 14) or how an adapter would be structured or used. There is no teaching of oval shaped channel tips. There is no teaching of the channels having individual sleeves to prevent orbital rotation, where such sleeves would be located, or how they would be structured or used.
3. The amendment filed January 15, 2002 is objected to under 35 U.S.C. 132 because it introduces new matter into the disclosure. 35 U.S.C. 132 states that no amendment shall introduce new matter into the disclosure of the invention. The added material which is not supported by the original disclosure is as explained above.

Applicant is required to cancel the new matter in the reply to this Office Action.

4. This application repeats a substantial portion of prior Application No. 09/385519, filed Aug 30, 1999, and adds and claims additional disclosure not presented in the prior application. Since this application names an inventor or inventors named in the prior application, it may constitute a continuation-in-part of the prior application. Should

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applicant desire to obtain the benefit of the filing date of the prior application, attention is directed to 35 U.S.C. 120 and 37 CFR 1.78.

1. Claims 1-4, 14-20 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claims 1 and 18, "all of said open distal ends... micro titration place [sic]" is unclear because the sizing is described relative to wells, which are not positively recited elements of the invention. In claims 1 and 20, it is not clear what structural limitations are intended by the statements of intended use to avoid mixing. Claim 15 is unclear because it recites a membrane whereas claim 1 precludes a membrane. In claim 17, "channel has an individual sleeve..." is unclear because it is unclear where the sleeve is located—is it part of the channel or the rack? Note that there is no disclosure in the specification of such a feature.

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States;

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

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3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating

obviousness or nonobviousness.

5. Claims 1, 15, 18, 20 are rejected under 35 U.S.C. 102(b) as being anticipated by Goodman.

Goodman teaches a pipette tip having tubular body 37, 65 in pressure communication with tips 23 via membrane 19, , which can be provided in pairs (Figure 1) or fours (Figures 20, 21). The tips are structurally capable of fitting together in well 25 or separately in wells 57 of suitable size. In this rejection, claim 1 has been interpreted to agree with claim 15, i.e., to have a membrane.

6. Claims 1, 4, 14, 18-20 are rejected under 35 U.S.C. 102(e) as being anticipated by Treptow et al.

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Treptow teaches a pipette tip having two conical tips extending from a single tubular body for receiving sample and reagent separately into the same pipette tip (Figure 11; col. 5, lines 31-33). No membrane is shown in Figure 11. An opening 13 is provided, which is structurally capable of attaching to different pipettes with different plunger lengths. The tips are structurally capable of fitting together or separately in wells of suitable size.

7. Claims 1, 3-4, 14, 18-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Treptow et al. as applied to claims 1, 4, 14, 18-20 above, and further in view of Goodman.

Treptow fails to teach four tips on one pipette tip or explicitly teach fitting all the channels in one well and individual wells.

The teachings of Goodman are given above.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to provide four conical tips on the device of Treptow in order to simultaneously pipette four reagents into a common tip device as an alternative to two reagents as taught by Goodman. With respect to the alternative rejections of claims 1, 4, 14, 18-20, it would have been obvious to size the channels of Treptow to fit in a single well and then individual wells in order to transfer the same fluid to individual wells as taught by Goodman.

5. Claims 15-16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Treptow alone or Treptow and Goodman as applied to claim 1 above, and further in view of Raybuck.

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The primary references fail to teach an oval shaped tip or a filter to prevent contamination.

Raybuck teaches a pipette tip with an oblique opening, which results in an oval cross-section at the opening of the tip (figure 7) and a filter 18 to prevent aerosol contamination.

It would have been obvious to provide the tip of Treptow or Treptow and Goodman with an oblique opening as taught by Raybuck in order to prevent sealing of a flat tip against a flat well bottom as was known in the art. It would have further been obvious to provide aerosol filters as taught by Raybuck in the channels in order to keep aerosols from contaminating the pipetter.

6. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

7. Claim 2 is rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 1 of U.S. Patent No. 6338825 in view of Treptow.

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8. The patented claim teaches the invention of instant claim 2 with the exception of the negative limitation precluding a membrane.

9. The teachings of Treptow are given above.

10. It would have been obvious to one of ordinary skill in the art at the time the invention was made to make the pipette tip of the patented claim without a membrane as taught by Treptow in order to permit free movement of air into and out of the top of the tip as displaced by the piston (col. 4, line 65).

8. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Hanaway et al. teach a multi-pipettor that uses an actuator mounted at member 30 as shown in Figure 8 to produce pressure differences in a cavity above a pipette array.

Crandall teaches a multi-outlet pipette head that mounts via tubular member 78.

Wilson teaches a pipette tip 28 with tubular body 32 and channels 42.

Stahli teaches a pipette tip, e.g., with tube 146 and channels 147 (Figure 11).

Fisher teaches a pipette tip manifold 21-169-10E with a mounting end and open channels.

Gavin teaches a pipette manifold with tubular member 136 and channels 132.

Note that channels 138 are not in communication with tube 136 (Figures 12-12b).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jan M. Ludlow whose telephone number is (703) 308-

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4039. The examiner can normally be reached on Monday-Thursday, 11:30 am - 8:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jill A. Warden can be reached on (703) 308-4037. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9310 for regular communications and (703) 872-9311 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0661.



Jan M. Ludlow
Primary Examiner
Art Unit 1743

jml
March 18, 2003